

### **REMARKS**

After entry of the instant Amendment, claims 1, 3-9, 12, 15, 16, and 19 remain in the application with claim 1 in independent form. Independent claim 1 has been amended to incorporate each of the elements of dependent claim 2. Dependent claims 5, 15, 16, and 19 (which are identical but for dependency) have each been amended to clarify the placement of the strippable protective layer and the role of the strippable protective layer in the use of the dicing/bonding sheet. Support for the amendments to claims 5, 15, 16, and 19 can be found in paragraph [0024] of the original application as filed and in the Figures of the instant application as filed. In particular, paragraph [0024] indicates that “the protective layer (4) preferably covers the . . . surface of the silicone-based adhesive agent layer (3)”, thereby providing support for the amendments that specify the position of the claimed protective layer in the dicing/bonding sheet. Relative to the claim language claiming that the protective layer is stripped prior to bonding said adhesive agent layer to said semiconductor wafer, support can be found when referring to Figures 4(a)-(f) and Figure 5, which clearly shows that the protective layer must be removed prior to bonding the semiconductor wafer to the adhesive agent layer. In view of the amendment of claim 1 to incorporate the elements of claim 2, claim 2 is presently cancelled. Claims 10, 11, 13, 14, 17, 18, and 20 are also presently cancelled as depending from cancelled claim 2, either directly or indirectly. Claims 6-9 were previously withdrawn from consideration subject to rejoinder should independent claim 1 be allowed. No new claims have been added. No new subject matter has been added through the amendments to the instant claims.

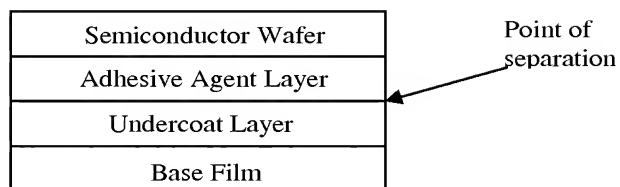
Claims 5 and 14-20 stand rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements.

Claims 1-4 and 10-13 stand rejected under 35 U.S.C. §102(b) over European Patent App. No. 0 571 649 (hereinafter the EP '649 application). Claims 5 and 14-20 stand rejected under 35 U.S.C. §103(a) over the EP '649 application.

In view of the amendment of independent claim 1 to incorporate the elements of dependent claim 2, the Applicants respectfully submit that the instant rejections have been overcome for reasons as set forth below. As such, the Applicants respectfully traverse the rejections of prior dependent claim 2 as those rejections now relate to independent claim 1. Further, with regard to the rejections of claims 5 and 14-20 under 35 U.S.C. §112, the Applicants respectfully submit that these rejections have been overcome through the amendment or cancellation of the claims at issue.

**Rejections of Prior Dependent Claim 2 Under 35 U.S.C. §102(b) Over the EP '649 Application**

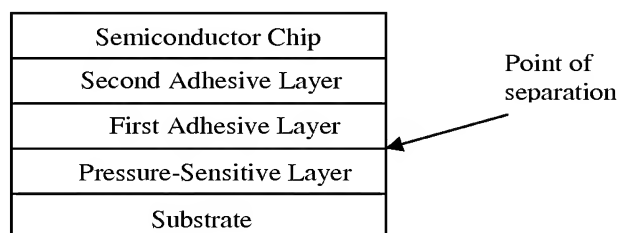
As the Examiner is aware, for a reference to anticipate a claim under 35 U.S.C. §102, the reference must teach each element of the claim. With regard to the rejections of claim 2 under 35 U.S.C. §102(b) over the EP '649 application, the Applicants respectfully submit that the EP '649 application does not teach each element of claim 2 (as now incorporated into independent claim 1 through amendment) such that independent claim 1 as amended is **not** anticipated by the EP '649 application. More specifically, the Applicants respectfully submit that the EP '649 application fails to teach a dicing/bonding sheet as claimed in the instant claims **with an adhesive agent layer that is bonded to a semiconductor wafer and that can be stripped from the undercoat layer after bonding to the semiconductor wafer**. The structure of the claimed dicing/bonding sheet is illustrated through the following schematic:



The ability of the adhesive agent layer to be stripped from the undercoat layer imparts structural features to the claimed dicing/bonding sheet and, in particular, to the adhesive agent layer, and such structural features cannot be ignored when comparing the instant claims to the teachings of the prior art. After all, an adhesive agent layer that is either not bonded to the semiconductor wafer **or** that cannot be stripped from the undercoat layer cannot satisfy each and every element of independent claim 1 as amended.

Turning to the teachings of the EP '649 application, the EP '649 application discloses a bonding sheet with a substrate, a pressure-sensitive layer bonded to the substrate, a first adhesive layer adhered to the pressure-sensitive layer, and a second adhesive layer adhered to the first adhesive layer. The second adhesive layer has an adhesive surface that is adhesively bonded to a semiconductor wafer (refer to column 2, line 47 to column 3, line 8 of the EP '649 application). Thus, to equate to the instantly claimed structure, **the first adhesive layer of the EP '649 application is comparable to the instantly claimed undercoat layer because the first adhesive layer is the layer that is disposed directly adjacent the second adhesive layer, on an opposite side of the second adhesive layer from the semiconductor wafer.** In effect, the EP '649 application includes **an additional layer** between the semiconductor wafer and the portion of the

dicing/bonding sheet that is separated from the wafer after stripping. The EP '649 application does not teach a single layer that **both** bonds to the semiconductor wafer **and** is capable of separation from the rest of the dicing/bonding sheet. To illustrate the teachings of the EP '649 application as distinguished from the instant claims, the EP '649 application teaches the following structure:



Because the EP '649 application requires that **both** the first adhesive layer **and** the second adhesive layer remain with the semiconductor wafer after cutting and after stripping the pressure-sensitive layer and the substrate from the wafer, EP '649 does not teach each and every element of the instant independent claim 1 as amended and, therefore, cannot anticipate independent claim 1 as amended.

Furthermore, there is no basis for the Examiner to conclude that independent claim 1, as amended, is obvious over the teachings of the EP '649 application due to the fact that the invention of EP '649 would be inoperable absent the presence of both adhesive layers taught therein. As such, the Applicants respectfully submit that independent claim 1 is both novel and non-obvious and, thus, is in condition for allowance. The remaining claims each depend upon the novel and non-obvious features of independent claim 1 such that the Applicants respectfully submit that these claims are also in condition for allowance. Finally, the Applicants respectfully request rejoinder of withdrawn claims 6-9 upon allowance of independent claim 1, from which claims 6-9 depend.

This Amendment is timely filed such that it is believed that no fees are presently due. However, the Commissioner is authorized to charge our deposit account no. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS, P.C.**

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